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11 STANWIX STREET, 15<sup>th</sup> FLOOR  
PITTSBURGH, PENNSYLVANIA 15222-1319  
TELEPHONE 412.297.4900  
FAX 412.209.0672

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**DATE:** October 15, 2004

**TO:** Joseph Hail III  
**FIRM/COMPANY:** USPTO  
**PHONE NO.**  
**FAX NO.** 703-305-3579

**FROM:** John A. Monocello III  
**TELEPHONE:** 412-297-4705

**NUMBER OF PAGES (including cover page):** 6

**COMMENTS:**

Dear Examiner Hail:

For your convenience and information, I have attached a courtesy copy of the Provisional Election With Traverse we filed today in the above-identified case. You will recall that we discussed this case at length on the telephone on October 12, 2004. Please let me know if you have any questions or concerns.

Sincerely,  
John A. Monocello III

**CLIENT/MATTER NO.:** 6637.0004

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NO. 701 P. 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Thomas C. Rolle

Serial No. 09/550,813

Filed: April 18, 2000

Art Unit: 3723

Patent Examiner: Morgan, Eileen P.

Our Ref: 94-042 CIP/CIP

METHOD AND COMPOSITION  
FOR REMOVING COATINGS  
WHICH CONTAIN  
HAZARDOUS ELEMENTS

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandra, VA 22313-1450

October 15, 2004

**PROVISIONAL ELECTION WITH TRAVERSE**

This Response is filed in accordance with 37 CFR 1.111 and 1.143 to a Restriction Requirement issued by the Examiner on October 6, 2004. The Applicants will provisionally elect and traverse as stated below.

**Background**

Respectfully, the Applicants are troubled by, and fervently disagree, with the latest office action issued by the Examiner. This case has languished in United States Patent Office for over four years. The Examiner's two prior restriction requirements in this case contributed to this delay. Further contributing to the delay is, respectfully, the Examiner's seeming unwillingness to address the Applicants' arguments with respect to the central reference cited by the Examiner in this case, U.S. Pat. No. 6,037,469 to Broom et al. ("Broom et al.") The Applicants have argued, several times, regarding whether Broom et al. qualifies as prior art under 35 U.S.C. 102(e) and

whether Broom et al. is analogous prior art. But the Examiner either entirely ignored or inadequately addressed Applicants' arguments. For example, the Examiner clearly never addressed Applicants' argument with respect to Broom et al. not qualifying as a reference under 35 U.S.C. 102(e), and the Examiner provided a one sentence response to the Applicants' argument that Broom et al. is nonanalogous art. It is the Applicants' contention that the Examiner's failure to articulate the reasons for its rejection is in contravention to the Administrative Procedure Act, 5 U.S.C. § 706(2). See In Re Sang Su Lee, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (stating that the Patent Office must articulate its reasons for a rejection and that the Patent Office must provide an administrative record showing the evidence supporting a rejection accompanied by the reasoning supporting the rejection).

Accordingly, the Applicants were forced to appeal in order to have the Board consider their arguments that Broom et al. cannot qualify as anticipating prior art to support a rejection of Claim 15 under 35 U.S.C. 102(e) and that Broom et al. cannot support an obviousness rejection because Broom et al. is nonanalogous art. The cost to the Applicants in preparing the Appeal was great since a great amount of attorney time was necessary to prepare the Appeal Brief. This cost is in addition to the cost of prosecuting the application for over four years. The Applicants had looked forward to the Board hearing their appeal because they were confident in their position that the claims should be allowed over Broom et al. The Applicants were also looking forward to the Board finally hearing the Applicants' arguments, which until now have received inadequate attention.

But the Examiner chose to not respond to the Applicants' arguments and instead chose to impose a third restriction requirement. This is troublesome for many reasons, including (1) the simple fact that it is a third restriction requirement; (2) it is at a very late stage of the prosecution;

- (3) it will cause the application to be further delayed after languishing for over four years; and
- (4) the restriction requirement is clearly wrong.

While the Applicants strongly contend that the delay in the prosecution of this application is a violation of the Applicants' due process rights, the Applicants have decided not to file a Petition to the Commissioner for relief because such petition would almost surely further delay the prosecution – a result that the Applicants cannot afford.

The Applicants thank the Examiner's supervisor, Examiner Joseph Hail, for his courteousness and responsiveness for dealing with the Applicants' concerns on a telephone call with the Applicants' attorney, John Monocello, on October 12, 2004. Examiner Hail stated that the application would be handled specially, and that the prosecution would advance quickly in light of the foregoing circumstances.

With that said, the Applicants now turn to the Restriction Requirement at hand.

**Response to Restriction Requirement and Provisional Election of Group I**

The Applicants provisionally elect Group I with strong traverse.

The Examiner has grouped the Claims in the following three groups:

- I. Claims 4-9, drawn to a treatment material, classified in Class 51, Subclass 295.
- II. Claims 1, 2, 10-12, 14, and 15 drawn to a method of removing a coating, classified in Class 451, Subclass 28.
- III. Claims 13, drawn to a treatment material mixed in a paint system, classified in Class 106, Subclass 1.05.

The Examiner states that the inventions are distinct, each from the other "for the following reasons." The "following reasons" are, according to the Examiner, that the inventions

are unrelated and that they have different modes of operation and different effects. The Applicants respectfully disagree.

First, the Applicants do agree that Claims 1, 2 and 10-12 are claims to a method. Quite puzzling, however, is the Examiner's contention that Claims 14 and 15 are drawn to a method. Claims 14 and 15 clearly recite "a treatment material for use in a method for removing a coating, said coating having a hazardous metal or compound contained therein..." Unambiguously, Claims 14 and 15 are directed to a treatment material, not a method. Furthermore, Claims 14 and 15 are very similar to and have the same preamble as Claim 4, which strangely the Examiner has placed in a separate group "drawn to a treatment material." If Claim 4 of Group I is drawn to a treatment material, so too are Claims 14 and 15. Therefore Claims 14 and 15 should be in Group I.

Still further, and to illuminate the bizarre and errant nature of this restriction, the Applicants respectfully point out that Claims 14 and 15 are very similar to cancelled Claim 3, except Claim 14 recites an amount of solvent. In her two prior restrictions, the Examiner has consistently found that Claim 3 was to a treatment material, was not a method, and was in the same grouping as Claim 4-9. Therefore, if the Examiner considered cancelled Claim 3 to a treatment material, she should similarly consider Claims 14 and 15 a treatment material.

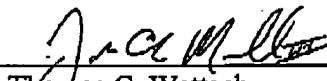
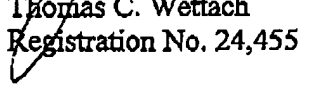
Additionally, Examiner has treated Claims 14 and 15 as claims to a treatment material being in the same group as Claims 4-9 in prior office action. (See for example the November 11, 2003 Office Action where it is clear that the Examiner was treating Claims 14 and 15 as treatment materials or "product claims"). This sudden turnaround in the Examiner's position with respect to Claims 14 and 15 this late in the game indicates that such a restriction is indeed arbitrary, capricious, and quite unnecessary.

The Applicants submit that the foregoing arguments apply with respect to Claim 13 as well.

Accordingly, Claims 13, 14 and 15 should be included in Group I, and the Applicants implore the Examiner to do so. If the Examiner includes Claims 13, 14, 15 into Group I, the Applicants would request that prosecution proceed on those claims (4-9, 13-15).

However, notwithstanding the Examiner's egregious abuse of the Rules and the prosecution process, the Applicants provisionally elect Group I of the Restriction Requirement issued by the Examiner October 6, 2004.

Respectfully submitted,  
THOMAS C. ROLLE, ET AL.

By   
Thomas C. Wettach  
Registration No. 24,455  
  
John A. Monocello III  
Registration No. 51,022

Cohen & Grigsby, P.C.  
11 Stanwix Street, 15th Floor  
Pittsburgh, PA 15222  
(412) 297-4900